

09/699,961

DEC 3 0 2005
MS15061201/MSFTP140USREMARKS

Claims 1, 3-5, 7, 18-20, 22, 31, 33-35, 43-44, 46-47 and 49-50 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1, 3-7, 33-35, 43-45 and 48-51 Under 35 U.S.C. §101

Claims 1, 3-7, 33-35, 43-45 and 48-51 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Although the claims as submitted in Reply to the previous Office Action dated May 16, 2005 encompass patentable subject matter, in order to expedite prosecution, the claims have been amended. Accordingly, withdrawal of this rejection is respectfully requested.

II. Objection to Claims 45, 48 and 51

Claims 45, 48 and 51 are objected to under 37 CFR §1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 45, 48 and 51 are patentable as explained in the Reply to the previous Office Action dated May 16, 2005. However, in order to expedite prosecution, the claims have been canceled.

III. Rejection of Claims 1, 3-5, 7, 18-20, 22, 31, 33-35 43-44 and 49-50 Under 35 U.S.C. §103(a)

Claims 1, 3-5, 7, 18-20, 22, 31, 33-35 43-44 and 49-50 stand rejected under 35 U.S.C. §103(a) as being unpatentable over McCollom (US 6,925,444) in view of Spiegel (US 6,629,079). Withdrawal of this rejection is respectfully requested for at least the following reasons. Neither McCollom nor Spiegel, either alone or in combination, teach or suggest all of the claim limitations.

The test of obviousness is whether "the subject matter sought to be patented and the prior art are such that the subject matter as a *whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art." (*Graham v. John Deere Co.*, 383 U.S. 1, 3 (1966) (emphasis added); *see also e.g., In re Dembiczak*, 175 F.3d 994, 998, 50 U.S.P.Q. 1614, 1616 (Fed. Cir. 1999)). In evaluating obviousness, the PTO must

09/699,961MS150612.01/MSFTP140US

conduct the factual inquiry as outlined in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). (See *In re Lee*, 277 F.3d 1338, 1342-43, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002)). The factual inquiry to be conducted includes determining: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. (See *Graham*, 383 U.S. 1, 17-18 (1966)). The PTO must "not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." (*In re Lee*, 277 F.3d at 1344, 61 U.S.P.Q.2d at 1434). The PTO cannot rely merely on conclusory statements and assertions of "common sense" to remedy deficiencies of the cited references. (*In re Lee*, 277 F.3d at 1344, 61 U.S.P.Q.2d at 1434). If the PTO relies on multiple prior art references as the basis for an obviousness rejection, it is not enough that all of the claim limitations appear in the prior art. To establish a *prima facie* case of obviousness, the PTO must also make an adequate showing of a suggestion, teaching, or motivation to combine the prior art references. (See *In re Dembiczak*, 175 F.3d 994, 999-1001, 50 U.S.P.Q. 1614, 1617 (Fed. Cir. 1999) (citing to *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)); see also *In re Lee*, 277 F.3d at 1343, 61 U.S.P.Q.2d at 1433). Only if the PTO establishes a *prima facie* case of obviousness does the burden of coming forward with evidence or argument shift to the applicant. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992)).

McCollum discloses an electronic wishlist and shopping cart. (See e.g., McCollum at col. 2, lines 49-52 and col. 3, lines 2-8). Figs. 17-18 illustrate the user shopping cart process. (See McCollum at Figs. 17-18 and col. 18, line 18-col. 19, line 42). When a shopper selects an item for purchase, the user buy process connects to the consumer payment server and transmits a buy request to the merchant offering the item for sale. (See McCollum at col. 19, lines 1-4 and 17-19). When a buy summary is received from the merchant, the payment information is then provided to the wallet function and the wallet transmits the payment information to complete the purchase. (See McCollum at col. 19, lines 20-27). The user buy process then checks to see if more times are to be purchased, and if so, the user buy process then *allows the user* to browse the merchant advertisements, product listings or shopping cart for the next item to be purchased. (See McCollum at col. 19, lines 35-40).

09/699,961MS150612.01/MSFTP140US

Spiegel discloses the use of multiple shopping baskets associated with different roles of a user (e.g. work and personal use). (See e.g., Spiegel at col. 4, lines 4-16). The user selects the shopping cart that is appropriate for the user's current role, and the system adds the items selected by the user for purchase to the currently selected cart. (See e.g., Spiegel at col. 4, lines 12-16).

The subject claims all recite the limitation an ordering component to provide *concurrent purchasing* of at least two selected items *from different merchants without further intervention from a user* or similar limitations. Neither McCollum nor Spiegel, alone or in combination, teach or suggest this novel feature of the subject claims. The Examiner contends that McCollum discloses ordering of selected items from different stores at Figs. 18-19 and col. 18, line 65-col. 19, line 42. (See Office Action dated October 31, 2005 at p. 8). As explained *supra*, McCollum discloses a buy process that allows a user to buy one item at a time. Although a user may indicate that more than one item *is to be* purchased, the *buy process* does not provide for concurrent purchasing. (See McCollum at col. 19, lines 35-40). After a single item is purchased, the buy process returns control to the user and it is the user who browses the shopping cart for the next item to be purchased. (See McCollum at col. 19, lines 36-40). Thus, the buy process disclosed by McCollum requires a user intervention step between the purchasing of each item.

For at least the foregoing reasons, the cited prior art fails to render obvious the claimed subject matter as a whole. Accordingly, applicant's representative respectfully requests that this rejection be withdrawn.

IV. Rejection of Claims 4 and 19 Under 35 U.S.C. §103(a)

Claims 4 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over McCollum in view of Spiegel and further in view of Call (US 6,154,738). Withdrawal of this rejection is respectfully requested for at least the following reasons. Claims 4 and 19 depend from claims 1 and 18, respectively, which are allowable over McCollum in view of Spiegel and Call describes a cross-referencing server that allows a user to gather information on a product from a variety of sources using the Universal Product Code as a reference ID. (See Call at Abstract and col. 3, line 65 – col. 4, line 19). However, neither McCollum, Spiegel, nor Call, alone or in combination, disclose an ordering component to provide *concurrent purchasing* of at least two selected items *from*

09/699,961MS150612.01/MSFTP140US

different merchants without further intervention from a user and therefore these references do not render the claimed subject matter as a whole obvious. Accordingly, applicant's representative respectfully requests that this rejection be withdrawn.

09/699,961MS150612.01/MSFTP140US**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP140US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



David W. Grillo
Reg. No. 52,970

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731